

VIA eFILE

PATENT APPLICATION

Docket: 14531.86

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

In re application of)
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)
Peter J. Potrebic)
)Art Unit
Serial No.: 09/781,110)2623
)
Filed: February 9, 2001)
)
Confirmation No. 2976)
)
For: SYSTEMS AND METHODS FOR)
RECORDING FRAGMENTED PROGRAMS)
)
Examiner: Annan Q. Shang)
)
Customer No.: 47973)

SUPPLEMENTAL REPLY BRIEF OF APPELLANTS

VIA eFILE Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On June 28, 2007, the Examiner mailed a second Examiner's Answer ("6/28/07 Examiner's Answer") to respond to Appellant's timely-filed Reply Brief. This Supplemental

Reply Brief is being filed under the provisions of 37 C.F.R. § 41.43(b). This brief is being filed by at least Tuesday, August 28, 2007 and is, therefore, timely under 37 C.F.R. § 41.41.

I. INTRODUCTION

Appealed claims 1-5, 9-23, 25, 26, and 28-35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood *et al.* (Application 2003/0044165) in view of Kundson *et al.* (Application 2005/0273819), and further in view of Abbott *et al.* (U.S. Patent No. 5,973,679), and further in view of Yi (U.S. Patent No. 6,094,427).

Appellant respectfully submits that the 6/28/07 Examiner's Answer still fails to address the specific difference in the unique identifiers recited in claims 1 and 21, and as pointed out in the Appeal Brief. The 6/28/07 Examiner's Answer also fails to identify, in the prior art, a unique identifier that is distinguished and independent from a program title. The Examiner also continues to hold to the mistaken argument that an obviousness rejection cannot be overcome by showing that the individual references do not teach the claimed elements as argued by the Examiner. For these reasons, and the additional reasons set forth in the Appeal Brief and Reply Brief, the Examiner's rejections should respectfully be withdrawn and the claims be allowed.

II. ARGUMENT

A. *The Examiner Has Failed to Cite Prior Art Teaching the Limitation of a “Unique Identifier that Is Distinguished from a Program Title”*

As set forth in the Appeal Brief, each of the pending claims 1-5, 9-23, 25, 26, and 28-35, require a method that uses a unique identifier in the EPG data that "is distinguished and independent from a program title." The Examiner concedes that "Wood as modified by Knudson, fail to explicitly teach the claimed 'a unique identifier . . . [that] is distinguished and

independent form the a [sic] program title . . .” [6/28/07 Examiner’s Answer, at p. 7.] Thus, the only reference relied upon by the Examiner as teaching the claimed unique identifier is Abbott. [See *id.*] The Examiner is wrong.

1. Abbott Does Not Disclose the Claimed “Unique Identifier that Is Distinguished from a Program Title”

The Examiner, for the third time, cites to Abbott at col. 4, line 53 – col. 5, line 3, col. 7, lines 12-20, and col. 20, line 66 – col. 21, line 11 as teaching the claimed unique identifier. [*Id.*] These citations to Abbott are precisely the same citations that the Examiner relied on in the Office Action and the first Examiner’s Answer to argue that Abbott teaches that “a series is assigned a unique series identifier or series ID when stored.” [Office Action, at p. 5.] Applicant addressed each of these citations to Abbott in at pages 12-15 of the Appeal Brief, explaining that the “series” and “unique identifier” of Abbott are distinguished from the series and unique identifier of the claimed invention. In Abbott, a “series” consists of segments of a *single broadcast*, each of those segments of the same broadcast being assigned a “unique series identifier.” [See Abbott, at 7:21-31; Appeal Brief at pp. 12-15.] Thus, the “unique series identifiers” of Abbott are entirely inapposite to the unique identifiers of the present invention assigned to each of the programs in a fragmented program (claim 21), or to each of the fragmented programs in a selected category (claim 1).

Nowhere does Abbott teach a “unique series identifier” that identifies *the entire program as related to a category* of programs as required by claim 1. Nowhere does Abbott teach that the *same* “unique series identifier” is used with *different programs* to identify them as related to the

same category, which also is required by claim 1. The Examiner does not offer a single substantive rebuttal to these arguments in the Appeal Brief, and has therefore tacitly conceded the same. Because the “unique identifier” of Abbott is not the same between any program, Abbott does not teach a unique identifier for the fragments of a fragmented program that also is “distinguished and independent from a program title” as required by the claims. Consequently, the Examiner’s rejections should respectfully be withdrawn and the claims allowed.

2. The Examiner Commits Clear Error in Using Hindsight to Reconstruct the Claimed “Unique Identifier” by Combining Multiple References

Although far from clear, a plausible reading of the 6/28/07 Examiner’s Answer is that the Examiner is now attempting to combine three different references to reconstruct the single element of the claimed unique identifier. In other words, the Examiner may be combining the teachings of Wood, Knudson and Abbott to argue that the claimed unique identifier is found in the prior art. If this is indeed the Examiner’s argument, this approach of combining references to teach a single element of claim is a clear error.

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (April 30, 2007) recently reiterated the standing for rejecting a combination claim as obvious:

As is clear from cases such as [*United States v. Adams* [383 U.S. 39, 40, 86 S. Ct. 708, 15 L. Ed. 2d 572, 174 Ct. Cl. 1293 (1966)]], a patent composed of several elements is *not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art*. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely

upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

127 S. Ct., at 1741 (emphasis added). Thus, even under the flexible standard in *KSR*, each of the elements in a combination patent must be found in the prior art, whether taught in a reference or within the knowledge of one of ordinary skill in the pertinent art. Here, the element of the unique identifier is not found in the art, and the Examiner does not argue that this element was within the knowledge of one of skill in the art. Instead, the Examiner has used improper hindsight to reconstruct the element of the unique identifier from three different patents. [6/28/07 Examiner's Answer, at pp. 6-7.] In other words, the Examiner is not merely combining known elements from different references to arrive at the combination claimed by Applicant. The Examiner is piecing together references to construct an ***unknown*** element, and then combines that constructed unknown element with other elements to arrive at the claimed combination. This type of *ex post* reconstruction is expressly prohibited by *KSR* and other Supreme Court precedent. See *KSR*, 127 S. Ct., at 1742 (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and ***must be cautious of arguments reliant upon ex post reasoning.***”) (emphasis added); accord *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, at 36, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966)(warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight”); *Monroe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (6th Cir. 1964).

3. **The Examiner Has Not Provided the Required “Reason that Would Have Prompted a Person of Ordinary Skill in the Relevant Field to Combine the Unique Identifier of Abbott with that of Wood and Knudson**

Under *KSR*, a *prima facie* case of obviousness requires a “reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 127 S. Ct., at 1741. The Examiner has failed to provide this required “reason” for combining the teachings of Abbott with those of Wood and Knudson.

The Examiner argues that the reason one of skill in the art would have combined the cited references is because “Wood, Knudson, Abbott and Yi are in the same field of endeavor, i.e., recording TV programs, shows or video and reproducing the recorded programs[.]” [6/28/07 Examiner’s Answer, at pp. 6-7.] Again, the Examiner is wrong. Abbott has nothing to do with recording TV programs, shows or video. Abbott is titled “SYSTEM AND METHOD FOR MEDIA STREAM INDEXING.” As explained in detail at pages 11-12 of the Appeal Brief, Abbott teaches a method and system to format or arrange program material for transmission to a viewer. [Abbott, at 1:66-2:1.] Specifically, Abbott dissects the program material into various components, and establishes an object hierarchy to facilitate transmission and synchronization of the components when presented to the viewer. [*Id.* at 2:1-8.] The purpose of organizing program data into a hierarchy is to allow the “program material to be provided to the viewer in an interactive and customized manner without changing or modifying . . . the program data.” [*Id.* at 5:29-33.] Thus, Abbott is *not* “in the same field of endeavor, i.e., recording TV programs, shows or video and reproducing the recorded programs” as Wood and Knudson as argued by the

Examiner. Consequently, the Examiner has provided no “reason that would have prompted a person of ordinary skill in the relevant field to combine” the teachings of Abbott with Wood and Knudson, as required the Supreme Court in *KSR*. Even if it were proper to use multiple references to reconstruct individual elements of a combination claim, which it is not, the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness because the Examiner has not provided the required “reason that would have prompted a person of ordinary skill in the relevant field to combine” those references. The Examiner’s rejection should respectfully be removed and the claims allowed in their present form.

III. CONCLUSION

For the foregoing reasons, and the additional reasons set forth in the Appeal Brief, and Reply brief previously filed by the Appellant, the Appellant respectfully requests the Board to overturn the Examiner’s rejections of the appealed claims 1-5, 9-23, 25, 26, and 28-35 and to allow these pending claims in their present form.

Dated August 28, 2007.

Respectfully submitted,



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